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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/319,782      | 04/19/2000  | JACQUES DROUIN       | 480848.90018        | 3565             |

25545 7590 02/26/2002  
GOUDREAU GAGE DUBUC  
800 PLACE VICTORIA, SUITE 3400  
MONTREAL, QUEBEC, H4Z 1E9  
CANADA

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| EXAMINER |
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KATCHEVES, KONSTANTINA T

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| ART UNIT | PAPER NUMBER |
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1636

DATE MAILED: 02/26/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/319,782

Examiner

Konstantina Katcheves

Applicant(s)

DROUIN ET AL.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22-47 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Claims 22-47 are pending in the instant application.

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-38 and 39, drawn to an isolated oligonucleotide, construct and host cell classified in class 435, subclass 23.1.

Group II, claims 40, 41 and 42, drawn to a method of screening for a compound classified in class 435, subclass 6.

Group III, claims 43-46, drawn to a protein complex classified in class 530, subclass 350.

Group IV, claim 47, drawn to a method for affecting multimerization *in vitro* within a cell, classified in class 435, subclass 69.1.

The inventions listed as Groups I, II, III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The invention of Group I relates to an isolated oligonucleotide, construct and host cell. The invention of Group II lacks unity with the other inventions because it is drawn to screening for unique compounds or

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compositions that modulate the activity of Nur response elements, which the oligonucleotides of Group I may or may not comprise. Moreover, the screening method claimed is in no way unique in the art. The method steps recited in Group II comprise contacting a sample with a host cell and comparing the level of expression of a reporter gene in the presence and absence of the compound of interest.

Group III differs from each of Groups I and II because the invention of the instant claims is drawn to a protein complex including a Nur receptors whereas Group I is drawn to nucleic acids while Group II is a method of screening. Proteins in general are unique from even the nucleic acids that encode them. Proteins have specific functions within the cell as mediators of cell processes whereas nucleic acids, including coding and non-coding regions, generally encode the proteins that are expressed. Also, because of the degeneracy of the genetic code, several different nucleic acid codons may code for the same amino acid in a protein. Thus, the nucleic acid sequence is not necessarily obvious from the protein. Moreover, the instant invention is drawn to a protein complex. The proteins that interact in the complex require specific motifs and regions that must interface for the complex to even be stable.

Finally, Group IV differs from each of Groups I, II and III because the invention of Group IV is drawn to a method of bringing about or facilitating the multimerization of proteins *in vitro* within a cell. Protein interactions are complicated and difficult to understand. The formation of protein complexes are affected by their cellular environment in addition to motifs required for the protein to fold in the appropriate conformation such that the members of the complex can even interface. Any method relating to the multimerization of proteins would be

inherently complicated and involve method steps and intermediates not involved in the inventions of any of the above groups.

### *Conclusion*

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (703) 305-1999. The examiner can normally be reached on Monday through Friday 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3388.

Konstantina Katcheves  
February 12, 2002

  
REMY YUCEL, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600